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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,521	01/23/2002	Michael J. Sullivan	B01-13	9600

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ACUSHNET COMPANY
333 BRIDGE STREET
P. O. BOX 965
FAIRHAVEN, MA 02719

EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,521

Applicant(s)

SULLIVAN, MICHAEL J.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 13, 14 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 15-25 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Applicant's election of alkylphthalates is acknowledged. Although applicant designates claims 4, 23, 24 and 29 as not being drawn to the elected species, these claims do include alkylphthalates as one potential species within their generic definition of plasticizer. Claims 9-11, 13, 14 and 26-28 are considered withdrawn.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 16, 18, 19, 23-25 and 29-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Yokota '157 patent.

Yokota exemplifies (#1) a polyurethane golf ball cover that contains dioctylphthalate other plasticizers such as dibutyl phthalate (col. 4 line 29) can be used. There can be multiple layers beneath the cover (col. 5 line 6).

Claims 1-5, 16 18, 19, 21-25, 29 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Dusbiber '061 Patent.

Dushiber produces golf balls having a urethane core or cover (abstract). A plasticizer such as diethylhexyl phthalate (col. 4 line 17) can be included. Dioctyl adipate is actually used in example 5.

Claims 1-5, 16-18, 23-25 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Kato '663 Patent.

Kato discloses a multilayer golf ball. The center can be a plasticized urethane rubber (col. 2 line 66). The plasticizer can be a phthalate (col. 2 line 42).

Claims 1-8, 12, 23-25, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Murphy '253 patent in view of Yakota '157 or Dusbiber '061.

Murphy discloses urethane foams (abstract). The material can be used in covered golf balls (col. 7 line 12). Phthalate ester plasticizers can be included (col 6 line 30). Specific pthalates are not disclosed.

Yokota (col. 4 line 29) and Dusbiber (col. 4 line 17) list common phthalate plasticizers such as dibutyl phthalate urethanes. It would have been obvious to use dibutyl phthalate as the phthalate in Murphy's ball.

Claims 1, 16, 18-22 and 29-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Sullivan '618 Patent.

Sullivan discloses four layer golf balls having a urethane outer cover (abstract). The outer cover is thin (col. 21 line 37) and can contain plasticizer (col. 21 line 66).

Claims 1-6, 16, 18-25 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Sullivan '618 Patent in view of Yokota '157 or Dusbiber '061.

Sullivan suggests plasticizers, but does not name any species.

Yokota (col. 4 line 29) and Dusbiber (col. 4, line 17) list dibutyl phthalate as a suitable plasticizer for urethanes.

It would have been obvious to use any common plasticizer in Sullivan's ball for the expected effect.

Claims 1-5, 15-25 and 29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Maruko '573 Patent.

Maruko produces three or four layer golf balls. One of the middle layers is a blend of thermoplastic, rubber powder, filler and plasticizer (col. 3 line 30). Resin K (table 3) is a blend of urethane, polybutadiene powder and DOP. DOP is assumed to be di (ethylhexyl) phthalate, which is a dioctylphthalate. "Ethylhexyne" is apparently a misprint.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (571) 272-1084. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/af
July 13, 2004.

